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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,154	12/20/2001	Timothy G.J. Ehr	29985/01-028	1216

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EXAMINER

FOREMAN, JONATHAN M

ART UNIT PAPER NUMBER

3736

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,154

Applicant(s)

EHR ET AL.

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-10 and 13-30 is/are pending in the application.
- 4a) Of the above claim(s) 8,9 and 20-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,10 and 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/2/05 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/2/05 has been entered.

Drawings

2. The drawings were received on 9/2/05. These drawings are acceptable.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 6 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,919,188 to Shearon et al.

In regards to claim 1, 6 and 10, Shearon et al. discloses an elongated tube (10b) including an open proximal end, a closed distal end and a single opening (22a) in a sidewall thereof, the elongated tube being slidably received in a tubular sheath (Col. 3, lines 56 - 58), the tubular sheath (8b) including an open proximal end, a closed distal end and at least two axially spaced apart openings (36) in a sidewall thereof. The tube is slidable within the sheath allowing the openings of the tube to be selectively aligned with one of the axially spaced apart openings of the sheath at a time (Col. 3, lines 62 - 65) . The tube is frictionally received in the sheath so that engagement between the inside

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surface of the sheath and the outside surface prevents fluid communication through the tubular sheath and between the inside surface of the sheath and the outside surface of the tube (Col. 4, lines 23 – 25).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4 – 6, 10, 13, and 15 – 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,168,703 to Kenigsberg.

In regards to claims 1, 4 – 6, 10, 13, and 15 – 18, Kenigsberg discloses an elongated tube (22) including an opening and a closed distal end (Col. 3, lines 22 – 24), the tube being received in a tubular sheath (Col. 3, lines 18 – 20), the tubular sheath (12) having at least two spaced apart openings (20), the tube being slidable within the sheath to allow the opening of the tube to be aligned with the openings of the sheath (Col. 4, lines 57 – 64), the proximal end of the elongated tube is disposed outside of the proximal end of the sheath, the elongated tube comprises two markings (28), one of the markings being aligned with the proximal end of the tubular sheath when the opening of the elongated tube is aligned with one of the openings of the tubular sheath, the other of the markings being aligned with the proximal end of the tubular sheath when the opening of the elongated tube is aligned with the other opening of the sheath (Col. 3, lines 41 – 56), the proximal end of the elongated tube is connected to a pressure transducer (Col. 3, lines 24 - 27).

The tubular sheath has an inside surface and the elongated tube has an outside surface, the elongated

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tube is frictionally received in the tubular sheath (Col. 3, lines 18 –20). In order for the device to perform, fluid communication through the tubular sheath between the inside surface of the tubular sheath and the outside surface of the elongated tube must be prevented. Otherwise, pressure readings would not be obtainable at the multiple sheath openings (20; Col. 4, lines 56 – 65).

Kenigsberg discloses the tubular sheath as preferably having an open distal end (Col. 2, line 60) and fails to disclose the distal end being closed. However, Kenigsberg teaches that elongated tube (22) as well as tubular members (32, 38) could have an open distal end or a closed distal end with an opening adjacent thereto (Col. 3, lines 22 – 24; Col. 3, line 67 – Col. 4, line 2; Col. 4, lines 15 – 19). Additionally, Kenigsberg teaches that it is desirable to keep the elongated tube (22) from extending past the distal end of sheath (Col. 3, lines 28 – 31). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the open distal end of the tubular sheath as disclosed by Kenigsberg to be a closed distal end with an opening adjacent thereto in that Kenigsberg discloses the two configurations as being equivalent and therefore interchangeable. Additionally, it would have been obvious to one having ordinary skill in the art to modify the open distal end of the tubular sheath as disclosed by Kenigsberg to be a closed distal end in order to keep the elongated tube (22) from extending past the distal end of the sheath.

Furthermore, disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). In the present case, Kenigsberg discloses the distal end “preferably open”, but does not teach away from a closed distal end having an opening adjacent thereto.

7. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,168,703 to Kenigsberg in view of U.S. Patent No. 6,259,938 to Zarychta et al.

In regards to claims 7 and 14, Kenigsberg fails to disclose the sheath of the pressure monitoring device comprising a radiopaque marker at a distal end thereof. However, Zarychta et al. discloses a pressure monitoring device having comprising a sheath having a radiopaque marker at a distal end thereof (Col. 4, lines 35 – 38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the sheath as disclosed by Kenigsberg to include a radiopaque marker at a distal end as taught by Zarychta et al. in order to facilitate positioning of the sheath within the patient (Col. 4, lines 31 – 33).

Response to Arguments

8. Applicant's arguments filed 9/2/05 have been fully considered but they are not persuasive. In view of Kenigsberg, Applicant has asserted that no *prima facie* case of obviousness has been established. However the Examiner disagrees. Kenigsberg teaches the equivalency of an open distal end and a closed distal end having an opening adjacent thereto (Col. 3, lines 22 – 24; Col. 3, line 67 – Col. 4, line 2; Col. 4, lines 15 – 19). In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art. MPEP 2144.06. In the present case, equivalency of an open distal end and a closed distal end having an opening adjacent thereto is taught in Kenigsberg. Kenigsberg suggests modifying open distal ends to include a closed distal end and an opening adjacent thereto. There is a reasonable expectation of success because Kenigsberg teaches that an open distal end and a closed distal end having an opening adjacent thereto are functionally equivalent. The prior art teaches or suggests all of the claim limitations. The Examiner maintains that the rejection of claims 1, 4 – 6, 10, 13, and 15 – 18 under 35 U.S.C. 103(a) as being unpatentable Kenigsberg is proper.

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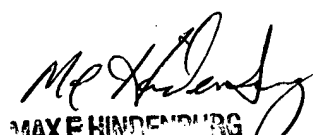
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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